REMARKS

Claim Rejections Under 35 USC § 112

These rejections are moot in view of the amendments to the form of the claims.

Claim Rejections Under 35 USC § 102

If a product-by-process claim produces a different product than that disclosed by a prior art reference, there is no anticipation. See *SmithKline Beecham Corp. v. Apotex Corp.*, 78 USPQ2d 1097 (Fed. Cir. 2006) citing *In re Luck*, 177 USPQ 523 (C.C.P.A. 1973) (Holding that product claims may include process steps to wholly or partially define claimed product and **to extent these process limitations distinguish product over prior art, they must be given same consideration as traditional product characteristics**.)

The claims are rejected as allegedly obvious over US 2003/0104198, which is now granted patent US 6,773,814, which teaches that:

> Metal oxides may be titanium dioxide, zinc oxide, zirconium oxide, iron oxide, cerium oxide and/or chemical mixtures of these metal oxides with each other and/or chemical mixtures of these metal oxides with aluminium oxide and/or chemical mixtures of these metal oxides with silicon dioxide. The origin of the metal oxides is not restricted. For example, metal oxides originating from a pyrogenic process, a sol-gel process, a plasma process, a precipitation process, a hydrothermal process or from mining processes or from combinations of the above-named processes may be used.

No details of any of the possible disclosed processes are provided by US '198.

The claims of the present application specify that the hydrothermal treatment is carried out in a closed container at a temperature of 140 to 360°C.

"Where a product-by-process claim is rejected over a prior art product that appears to be identical, although produced by a different process, the burden is upon the applicants to come forward with evidence establishing an unobvious difference between the claimed product and the prior art product." (Emphasis added.) See *Atlantic Thermoplastics Co. Inc. v. Faytex Corp.*, 23 USPQ2d 1801 (Fed. Cir. 1992) citing *In re Marosi*, 218 USPQ 289 (Fed.Cir. 1983).

Accordingly, attached is a declaration demonstrating that products obtained by a process according to the invention compared to a product obtained by, e.g., hydrothermal treatment at 105°C, have higher maximum UV A absorption (means better protection from

UV-A) and have a significantly better dE-value (means a decrease in the graying of the products). Although not necessary, the declaration also compares the dE-value of a claimed product to dE-values of two market products.

Since applicants established that the claimed products are different than the product of the prior art, withdrawal of the anticipation rejection is respectfully requested.

Additionally, applicants also note that one of ordinary skill in the art would not have expected the significant results achieved with the claimed invention based on the disclosure of the prior art. As such, there would be no basis for a rejection based on obviousness.

Claim Rejections Under 35 USC § 103

All these rejections combine the reference discussed above in combination with a further reference to render dependent claims allegedly obvious.

None of the secondary references cure the deficiencies of the reference discussed above. Thus, for at least said reason, there is no obviousness.

Reconsideration is respectfully solicited.

The Commissioner is hereby authorized to charge any fees associated with this response or credit any overpayment to Deposit Account No. 13-3402.

Respectfully submitted,

/Csaba Henter/

Csaba Henter, Reg. No. 50,908
Attorney for Applicants

MILLEN, WHITE, ZELANO & BRANIGAN, P.C.
Arlington Courthouse Plaza 1
2200 Clarendon Boulevard, Suite 1400
Arlington, VA 22201
Telephone: 703-243-6333
Facsimile: 703-243-6410
Attorney Docket No.: MERCK-3116

Date: October 27, 2008